

REMARKS

Claims 1-18 are pending in this application. Claims 19-22 have been withdrawn.

Claim 2 is objected to while claims 1-18 stand rejected as being allegedly unpatentable under 35 U.S.C. § 103. As to the rejections, claims 1-8, 13-16, and 18 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. patent 5,116,318 to Hillstead, in view of U.S. patent 5,843,089 to Sahatjian; claims 9-11 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hillstead and Sahatjian in view of Hyde et al. (EP 055396041); and claims 12 and 17 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hillstead and Sahatjian in view of Osborn, U.S. patent 5,409,495.

Objection to Claim 2

Claim 2 is objected to as being allegedly “redundant.” Reconsideration of this objection is requested as the disputed claim language is no longer recited in claim 1. Furthermore, even if the language remained in claim 1, the undersigned submits that claim 2 is not duplicative of that language. For one, claim 1 did not require that the stent contact the sheath, rather, it was the coating of the stent that was in contact with sheath not the stent itself, as in claim 2.

For at least these reasons, claim 2 is not redundant.

35 U.S.C. § 103

Without reaching the impropriety of combining these references, the undersigned submits that all of the cited references fail to disclose or suggest an expandable stent with a coating on at least a portion of an inner surface of the stent “wherein at least some of the coating on the inner surface of the stent has not been previously transferred to the stent from the compliant sheath,” as recited in claim 1. For at least this reason, claims 1-18 are patentable over the cited references.

The Office action cites two references in rejecting claim 1. The first, Hillstead, is entitled “Dilation Balloon Within an Elastic Sleeve” and regards an uncoated stent and dilation catheter system. The second, Sahatjian, is entitled “Stent Lining” and regards a coated balloon for delivering a stent. See Sahatjian Abstract. In Sahatjian a coated balloon, without a sheath, is used to deploy a stent and to “deposit[] a lining material, e.g., a hydrogel, in a desired region of the inner surface of a stent.” See Sahatjian col. 3, lns. 43-45; see also id., col. 3, lns. 49 - 59

(describing the process by which a coating is transferred from a balloon to a stent during the deployment of the stent). Thus, when compared to the recited claim language, Hillstead doesn't address coatings at all and in Sahatjian it is clear that all of the coating on the inner portion of the stent has been transferred from the balloon to the stent. This is, of course, different from claim 1, which recites that at least some of the coating on the inner surface of the stent has not been transferred to the stent from the sheath. Consequently, claim 1 is patentable over each reference alone and over both of them if they are improperly combined.

As to the other cited references, they are even further removed.

July 21, 2004, Advisory Action

The advisory action alleges that the new wherein clause in claim 1 should be given no patentable weight arguing that it "merely states the result of the limitations in the claim." This assertion is, however, misplaced as the wherein clause provides additional description regarding the coating on the stent. It does not regard the result of any action as suggested in the Office action. Reconsideration, is, therefore, requested.


CONCLUSION

For at least these reasons the undersigned requests allowance of the amended claims.

Should the Examiner require any additional information regarding this Response, the Examiner is invited to contact the undersigned at (202) 220-4311.

Respectfully submitted,

Date: August 9, 2004



Fred T. Grasso
Reg. No. 43,644

KENYON & KENYON
1500 K Street, N.W.
Suite 700
Washington, D.C. 20005
(202) 220-4311
(202) 220-4201 (fax)